

REMARKS

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested.

Status

As is correctly reflected in the Office Action Summary, Claims 2-6 and 8-17 are pending. Claims 1, 7, and 18-21 had already been canceled. Claims 2-6 and 8-17 stand rejected.

Summary of Claim Amendments

By the foregoing amendments, Claims 4-6 were canceled without prejudice or disclaimer to Applicants filing one or more continuing applications directed to previously-presented subject matter.

Also by the foregoing amendments, Claim 2 was amended to characterize the regime or regimen as a cosmetic/pharmaceutical regime or regimen, to specify that said regimes or regimens are directed to treating disorders of the barrier function of human skin, to specify that the individual who employs the regime or regimen is one afflicted with a disorder of the barrier function of his or her skin, and to specify that an effective skin barrier function-restoring amount of compound is administered. Support for the amendments to Claim 2 are found throughout the Specification, especially at Page 1,

Paragraph 0003; Page 5, Paragraph 0024; and original Claims 1 and 2. Accordingly, no new matter has been added.

Further by the foregoing amendments, Claim 8 has been amended to clarify that said at least one polycyclic aromatic compound (I) is a PPAR receptor activator. Support for this amendment may be found at least at Page 2, Paragraph 0007 and Pages 3-4, Paragraphs 0016-0022 of the Specification. Accordingly, no new matter has been added.

Finally by the foregoing amendments, Claims 22-31 were added. Support for these claims may be found throughout the Specification, including the original claims. Accordingly, no new matter has been added.

Interview

The undersigned and Mr. Norman Stepno (Registration No. 22,716) wish to thank Examiner Jiang for the courtesies extended during the personal interview ("Interview") conducted on February 19, 2004. During the Interview, the pending claims, possible claim amendments, and the cited publication were discussed.

Rejection Under 35 U.S.C. § 102(b) Over U.S. Patent No. 5,763,487 to Bernardon

Turning now the sole remaining rejection, Claims 2-6 and 8-17 were rejected under 35 U.S.C. § 102(b) as purportedly unpatentable over U.S. Patent No. 5,763,487 to Bernardon et al. ("Bernardon"). *See Final Official Action, Pages 3-4*. This rejection is respectfully traversed.

As previously noted by Applicants, to anticipate a claim, a single source must contain all elements of the claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). Moreover, missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716 (Fed. Cir. 1984). Applicants maintain that Bernardon does not contain all elements of Claims 2-3, 8-17, or 22-31.

According to the Examiner, "Bernardon's method inherently treats the barrier function of human skin . . . as claimed herein since Bernardon's method steps are [the] same as the instant method steps." *See Final Official Action, Page 4*. Applicants respectfully disagree. Claims 14-17 of Bernardon recite only methods for treating alopecia (Claim 14), a cardiovascular disorder (Claim 15), or a dermatological, rheumatic, respiratory, cardiovascular, or ophthalmologic disorders (Claims 16-17), wherein said methods simply comprise administering effective amounts of compositions containing compounds of Bernardon's formula (I).

Applicants' methods are directed to cosmetic/pharmaceutical regimes or regimens for treating disorders of the **barrier function of human skin**, comprising administering, topically in Claims 22-31, **to an individual afflicted with a disorder of the barrier function of his or her skin an effective skin barrier function-restoring amount** of at least one polycyclic aromatic compound according to **instant formula (I)**. Unlike Bernardon, Applicants' methods require an individual afflicted with a disorder of the barrier function of his or her skin. Further unlike Bernardon, Applicants' methods require

administering an effective skin barrier function-restoring amount of at least one polycyclic aromatic compound according to formula (I).

Because Bernardon does not contain all elements of Claims 2-6, 8-17, or 22-31, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(b) rejection over Bernardon.

Bernardon Also Fails To Render Obvious Claims 2-6, 8-17, or 22-31

While Applicants believe the foregoing anticipation discussion renders moot all possible obstructions to issuance of Claims 2-6, 8-17, or 22-31, solely for the sake of prosecution efficiency Applicants also wish to indicate why Bernardon fails to render these claims obvious.

When applying 35 U.S.C. § 103, four tenets of patent law must be adhered to: (1) the claimed invention must be considered as a whole, (2) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination, (3) the references must be viewed without the benefit of impermissible hindsight vision, and (4) a reasonable expectation of success is the standard with which obviousness is determined. *See M.P.E.P.* § 2141, citing *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 (Fed. Cir. 1986). To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference(s) must teach or suggest all of the claim limitations. *See M.P.E.P.* § 2142.

Moreover, mere identification of each claimed element in the prior art is NOT sufficient to negate patentability. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Instead, there "must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor." *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 536 (Fed. Cir. 1998). Otherwise, sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. *Rouffet*, 149 F.3d at 1357.

Applicants maintain that a *prima facie* case of obviousness cannot be made out using Bernardon because, as explained in the foregoing section, Bernardon fails to disclose all elements of Applicants' claims. Applicants further maintain that a *prima facie* case of obviousness cannot be made out because there is nothing in Bernardon to motivate or suggest to one of skill in the art to modify Bernardon's methods so as to treat disorders of the barrier function of skin. By extension, even if one of skill in the art had been so motivated, there would be no reasonable expectation of success for such a modification, and thus no *prima facie* case of obviousness, because the disorders addressed by Bernardon are so very different than disorders of the barrier function of skin. For example, alopecia ("loss of hair, baldness"), arteriosclerosis ("a degenerative arterial disease marked by hardening and thickening of the vessel walls"), and ophthalmological ("drugs used in the treatment of eye disease") conditions are very different from disorders of the barrier function of skin. *See Exhibit A for the definitions according to the Sixth Edition of the*

McGraw-Hill Dictionary of Scientific and Technical Terms; see also Bernardon at Column 6, Line 39; Column 6, Lines 42-43; and Column 6, Lines 19-20, respectively.

In view of the foregoing, Applicants maintain that Bernardon fails to render Claims 2-6, 8-17, or 22-31 obvious.

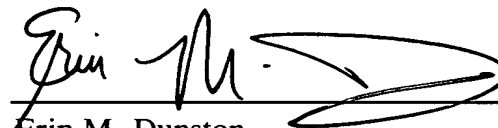
CONCLUSION

From the foregoing, further and favorable consideration in the form of a Notice of Allowance is respectfully requested and earnestly solicited.

As a precaution, Applicants are filing, concurrently, a Notice of Appeal. However, if there are any questions relating to this response, or the application in general, it would be greatly appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,
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Date: February 26, 2004